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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,760	03/07/2000	Krishan L. Taneja	BP9806US-CP1	9118
23544	7590	08/13/2004	EXAMINER	
BRIAN D. GILDEA APPLIED BIOSYSTEMS 15 DEANGELO DRIVE BEDFORD, MA 01730			SITTON, JEHANNE SOUAYA	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

317.

Advisory Action**Application No.**

09/520,760

Applicant(s)

TANEJA, KRISHAN L.

Examiner

Jehanne Souaya Sitton

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 06 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see Attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: 12.Claim(s) rejected: 10 and 11.Claim(s) withdrawn from consideration: 1,2,29,31,33,34,38-40,45,47,49,50,54-56,64,65 and 78-80.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Attachment

1. The amendment filed July 6, 2004 will not be entered because it raises new issues under 35 USC 112/2nd paragraph. Newly proposed claim 10 is confusing as it states that each probe is “of 10 to 30 subunits in length”, but also states “wherein one or more PNA probes of the set... comprise a probing nucleobase sequence or their complements selected from the group consisting of...”. As such, it is unclear if the claims are limited to the whole nucleobase portion recited in a SEQ ID NO: or only 10-30 subunits. Additionally, the claim (10) recites non elected embodiments. As presently written, the claim is not drawn to a set containing all 118 probes (see interview summary dated 4/21/2003, where all 118 probes were elected), or even a set which contains at least one of the probes of SEQ ID NOS: 1-9, which were searched. It is also noted that the response asserts that claims 55 and 56 were amended to be dependent from claim 10, but that claim 55 was previously withdrawn from consideration and not searched. Such claim is also drawn to a method, and not to a probe set as claimed in claim 10. As such, the proposed amendment will not be entered.
2. It is further noted that the proposed amendment is not compliant with current USPTO amendment practice. It lists claims as previously canceled when such claims were not previously canceled, ie: claims 1-2, and does not properly identify claims 55 and 56 as withdrawn.
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Sitton whose telephone number is (571) 272-0752. The examiner can normally be reached Monday-Thursday from 8:00 AM to 5:00 PM and on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (571) 272-0782. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



Jehanne Sitton

Primary Examiner

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8/9/04